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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,919	08/04/2003	Gerald Scott	117.0001-00000	4941
22882	7590	06/26/2006		
MARTIN & FERRARO, LLP 1557 LAKE O'PINES STREET, NE HARTVILLE, OH 44632			EXAMINER SHEEHAN, JOHN P	
			ART UNIT	PAPER NUMBER

1742

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/633,919

Applicant(s)

SCOTT ET AL.

Examiner

John P. Sheehan

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-16, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>Nov. 4, 2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group II claims 6 to 16 in the reply filed on April 18, 2006 is acknowledged. It is noted that in the response submitted April 18, 2006, applicants added new claims 21 and 22, which are dependent on elected claim 16. Accordingly claims 6 to 16, 21 and 22 are subject to examination.

### ***Claim Interpretation***

2. Claim 1 recites, "a precipitation-hardenable alloy core" (claim 6, line 3). The word "hardenable" has been interpreted to mean capable of being hardened but not necessarily in the hardened condition. In view this interpretation of the word, "hardenable", the phrase, "a precipitation-hardenable alloy core" is considered to encompass an alloy core that is made of an alloy that is capable of being precipitation hardened but is not in the precipitation hardened state and an alloy core that is made of an alloy that is in fact in the precipitation hardened state.

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> Paragraph***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 6 to 16, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a core rod made of the precipitation hardenable alloy composition recited in claim 7, does not reasonably provide enablement for all precipitation hardenable alloys. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

I. As presently drafted, claims 6 and 8 to 16, 21 and 22 encompass the use of a core rod made from any "precipitation hardenable" alloy. For example, claim 6 reads on any alloy that can be caused to have precipitates of a constituent form from a supersaturated solution, such as, aluminum alloys, copper base alloys, magnesium alloys, refractory metal base alloys, cobalt base alloys, nickel base alloys, copper base alloys, that is, every alloy in class 148, subclasses 405 to 419, of USPTO classification schedule. However, the specification is not enabling for such breadth but rather, teaches the use of only the alloy composition recited in claim 7 for the purpose of the instant invention. Applicants are advised that his rejection can be overcome by incorporating the limitations of claim 7 into claim 6.

II. In like manner, claims 6 to 15 encompasses casting any and all metal alloys. The specification is not enabling for such breadth in that applicants have disclosed the use of the instant invention with but a single alloy type, beryllium-copper alloys as recited in claims 16, 21 and 22. Applicants are

advised that his rejection can be overcome by incorporating the limitations of claim 16 into claim 6.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6 to 16, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. In claim 6, the last two lines, the meaning of the phrase, "a uniform sidewall thickness in a range of +/- 0.060 inches" is not clear. For example, does this language mean;

(1) that the side walls have a thickness of 0.06 inches +/-, that is, a thickness of about 0.06 inches; or

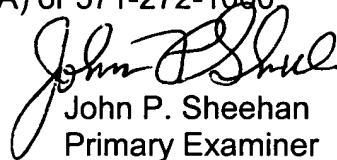
(2) that the sidewall has deviation in the thickness of plus or minus 0.06 inches?

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
John P. Sheehan  
Primary Examiner  
Art Unit 1742

jps